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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/353,270	07/14/1999	SUSUMU KUSAKABE	450100-4984	3256

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NEW YORK, NY 10151

EXAMINER

LEE, CHI CHUNG

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/23/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/353,270

Applicant(s)

KUSAKABE ET AL.

Examiner

Chi-Chung E Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7,8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in that it fails to define the preamble and the body consistently by the claim language.

Regarding claim 1, the preamble is directed to an information processing (i.e. method) but the body recites data storage means, management information storage means, management means, form means and encrypting means, which are apparatus and renders the claim inconsistent. Appropriate correction is required.

Claims 2-7 are rejected by virtue of their dependencies.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim 8 is rejected under 35 U.S.C. 102(e) as being clearly anticipated by Susaki et al (US 6,253,322 B1).

Susaki is directed to an electronic certification and authentication methods and systems.

As per claim 8, Susaki discloses a IC card 120 (i.e. data storage device) comprising a data storage area 203e for storing password as the data to implement certification and authentication services necessary in dealing with electronic commerce in an opening network environment, see figure 2 and column 8 lines 39-49; IC card control program area 203b and Cryptographic key generating program area 203c (i.e. management information storage means) for storing cryptographic key generating program (i.e. management information) containing a key pair necessary to access the external output prohibit area of data storage area, see figure 5 and column 7 lines 2-10. Susaki discloses the certificate authority updates user management information (i.e. the management information is renewed by an access from the external) and send the IC card to the service supplier, see column 9 lines 39-46.

As per claims 9-11, Susaki discloses IC card can be accessed from the terminal of service supplying unit through the reader/writer interface (i.e. predetermined transmission medium) in a contact state and the data transmitting and receiving program for data between a terminal and an IC card is stored in the memory, see column 7 lines 14-19. Susaki discloses the IC card comprises radio receiver 205 for performing communications with external equipment, see figure 2.

As per claims 12-14, Susaki discloses the user management information is supplied by membership certificate authority 3310 (i.e. an external information process device), see figure 17. Susaki discloses the public key of a member which can allocated to external output permit area (i.e. storage area to be managed) and is used to identify the external output permit area of the data storing area (i.e. said storage area), see column 18 and column 22 lines 45-52.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Susaki et al (US 6,253,322 B1) as applied to claim 8 above, and further in view of Takagi et al (US 5,408,082 A).

As per claims 14-15, Susaki does not expressly disclose the storage area to be managed is in a layer structure.

The examiner asserts a layer is a subsection or just a portion of a storage area used for storing information or data and one of the portions can be empty capacity. So for the purpose of applying art, a layer will be referred as a portion.

Takagi teaches an IC card with a hierarchical data structure that stores the data files in a file structure in a non-volatile memory; see column 3 lines 16-17.

At the time the invention was made, it would have been obvious to a person or ordinary skill in the art to store data in different portions of the storage area within IC card and managed them using different keys.

One of ordinary skill in the art would have been motivated to allow certain user to access the different portion and not having to carry around many IC cards (i.e. items) that would be more efficient and secure.

As per claims 31-38, the claimed steps corresponds to the functions of the elements of the apparatus claim 8-15, which has been rejected above, and thus rejected with the same reason applied thereto.

As per claims 16, Susaki discloses a IC card 120 (i.e. information processing card) comprising a data storage area 203e for storing password as the data to implement certification and authentication services necessary in dealing with electronic commerce in an opening network environment, see figure 2 and column 8 lines 39-49; IC card control

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program area 203b and Cryptographic key generating program area 203c (i.e. management information storage means) for storing cryptographic key generating program (i.e. management information) containing a key pair necessary to access the external output prohibit area of data storage area, see figure 5 and column 7 lines 2-10. Susaki discloses the certificate authority updates user management information (i.e. the management information is renewed by an access from the external) and send the IC card to the service supplier, see column 9 lines 39-46. Susaki discloses the IC card comprises a certificate authority certificate area 513 (i.e. reception means) for receiving and storing the certificate 809 based on the ID card's public key, see figures 2,3,7. It would be obvious to one of ordinary skill in the art to include a decoding means for decoding the encrypted certificate received from the certificate authority 170 because of the need to verify the certificate authority's certificate, see figure 7. Susaki disclose the IC card control program (i.e. storage control means) to control the management information stored in the data storage area, see column 9 lines 35-42.

As per claims 17-23, Susaki discloses IC card can be accessed from the terminal of service supplying unit through the reader/writer interface (i.e. predetermined transmission medium) in a contact state and the data transmitting and receiving program for data between a terminal and an IC card is stored in the memory, see column 7 lines 14-19. Susaki discloses the IC card comprises radio receiver 205 for performing communications with external equipment, see figure 2. Susaki discloses the user management information is supplied by membership certificate authority 3310 (i.e. an external information process device), see figure 17. Susaki also discloses the public key

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of a member which can allocated to external output permit area (i.e. storage area to be managed) and is used to identify the external output permit area of the data storing area (i.e. said storage area), see column 18 and column 22 lines 45-52.

As per claims 24-30, the claimed steps corresponds to the functions of the elements of the apparatus claim 16-23, which has been rejected above, and thus rejected with the same reason applied thereto.

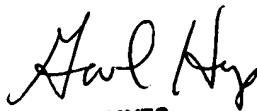
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chi-Chung E Lee whose telephone number is 703-306-4153. The examiner can normally be reached on 8 am - 5 pm, Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail O Hayes can be reached on 703-305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Chi-Chung Lee
May 16, 2003


GAIL HAYES
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100